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First Named Inventor: PEUKER, MARC

Application No.: 10/598994

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Group Art Unit 3728

Title: PACKAGE ASSEMBLY FOR DENTAL SUBSTANCES

BRIEF ON APPEAL

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]

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December 8, 2010
Date

/Tracey L. Riley/
Signed by: Tracey L. Riley

Dear Sir:

This is an appeal from the Office Action mailed on July 1, 2010, finally rejecting claims 55 through 58, 60 through 64, 73, 84, and 86 through 92, and is timely filed.

Fees

- ☐ Any required fee under 37 CFR § 41.20(b)(2) will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 37 CFR § 41.20(b)(2) and 1.17 which may be required to Deposit Account No. 13-3723.
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

A Notice of Appeal in this application was filed and received at the USPTO on October 8, 2010. Appellants request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer.

REAL PARTY IN INTEREST

The real party in interest is 3M Company (formerly known as Minnesota Mining and Manufacturing Company) of St. Paul, Minnesota and its affiliate 3M Innovative Properties Company of St. Paul, Minnesota.

RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 55 through 58, 60 through 64, and 66 through 92 are pending. Claims 55 through 58, 60 through 64, 73, 84, and 86 through 92 were finally rejected and are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments have been filed after the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 55 concerns a package assembly for placement on a surface, p. 7, ll. 13–21, and for storing and/or delivering substances such as dental substances. P.3, ll. 1–2. The package assembly includes at least one container including a base and a lid and at least one hinge connecting the base and the lid. P. 3, ll. 3–4. The base and the lid comprise first and second levers, and the container can be opened by moving the first and second levers towards each other. P. 3, ll. 5–12. The container contains at least one dental substance and is sealed with a breakable tamper-evident seal. P. 6, ll. 17–30.

Independent claim 87 concerns a method for providing dental substances, p. 4, ll. 25–29, including the step of providing a package assembly having at least one container having a base and a lid and at least one hinge connecting the base and the lid. P. 3, ll. 3–4. The base and the lid have first and second levers, and the container can be opened by moving the first and second levers towards each other. P. 3, ll. 5–12. The container contains at least one dental substance and is sealed with a breakable tamper-evident seal. P. 6, ll. 17–30. The method further includes opening the package assembly by pressing the two levers together. P. 4, ll. 28–29.

First Ground of Rejection

Claims 55 through 58, 61 through 64, 84, 86, 87, 89, and 90 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,249,963 (McGarrigle) in view of U.S. Patent No. 6,343,695 (Petrick et al.).

Second Ground of Rejection

Claims 60, 88, 91, and 92 were rejected under 35 U.S.C. § 103(a) as unpatentable over McGarrigle in view of Petrick et al. and further in view of U.S. Patent No. 4,991,759 (Scharf).

Third Ground of Rejection

Claim 73 was rejected under 35 U.S.C. § 103(a) as unpatentable over McGarrigle in view of Petrick et al. and further in view of U.S. Patent No. 5,660,273 (Discko, Jr.).

ARGUMENT**First Ground of Rejection**

Claims 55 through 58, 61 through 64, 84, 86, 87, 89, and 90 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,249,963 (McGarrigle) in view of U.S. Patent No. 6,343,695 (Petrick et al.). The Examiner indicated that McGarrigle describes each feature of independent claims 55 and 87 and concluded that when “the lid [of the device of McGarrigle] is closed down on the base the container is sealed and when the lid is removed from the base the seal is broken.” The Examiner indicated that McGarrigle does not disclose that the seal is a tamper-evident seal, but that it would have been obvious to apply a tamper-evident label to the sides of the container of McGarrigle as taught by Petrick et al. Appellants respectfully disagree at least because the proposed combination contradicts the teachings of McGarrigle, destroys the functionality of the tamper-evident label taught by Petrick et al., and does not result in a device having each limitation of claims 55 or 87. Accordingly, the combination of McGarrigle and Petrick et al. cannot render claims 55 or 87 obvious under 35 U.S.C. § 103(a), and it is respectfully requested that the rejection be reversed.

McGarrigle describes a dispenser for use by a dental assistant to enable light-curable compositions to be shielded from undesirable ambient light until such time as they are to be

applied. Abstract. The dispenser 10 comprises a container having a body portion 12 and a lid portion 14 hinged to the body portion by a pair of hinges 16 and 18 which enable the lid 14 to pivot. Col. 2, ll. 29–33. The inside of the container body 12 is divided into a series of “shallowed depressions” 20 and 22 for receiving a light sensitive bonding material. Col. 2, ll. 38–40. The liquid bonding agents are placed into their respective cavities by the dental assistant. Col. 3, ll. 29–30. It is important to maintain the device in a level position because the light-curable bonding agents contained in the depressions 20 and 22 are fluids, and therefore can be spilled. Col. 3, ll. 16–19. A pair of legs 30 and 32 are provided to maintain the dispenser 10 level while the bonding agents are placed into the depressions 20 and 22, col. 3, ll. 20–25, and a stabilizer member 30 is provided for the purpose of preventing the dispenser 10 from rotating relative to the index finger F when mounted on a user’s hand H. Col. 3, ll. 6–10.

Petrick et al. describes a business form having a number of distinct labels disposed on it. Abstract. At least one of the labels is dimensioned and configured to hold a removable cap on a medical container to indicate if the container cap has been tampered with. Abstract.

One of skill in the art would not logically make the combination proposed by the Examiner because such a combination would be contrary to the teachings of McGarrigle and would destroy the function of the tamper-evident label taught by Petrick et al. The Examiner indicated that the addition of a tamper-evident label to the device of McGarrigle “would alert the user to the fact that the container has been previously opened.” Office Action 7/12/10, p. 3. McGarrigle, however, teaches that the bonding agents are placed into the respective cavities of the device *by the dental assistant*. It is the *user* that places the dental material in the container and thus the *user* is aware of the fact that the container has been previously opened even in the absence of a tamper-evident label. Because the user of the device would already be aware that the container has been opened, a tamper-evident label would serve no purpose in the device of McGarrigle. Accordingly, the proposed combination cannot render claims 55 or 87 obvious under 35 U.S.C. § 103(a).

Even if the device of McGarrigle were combined with the tamper-evident label of Petrick et al., the proposed combination cannot render claims 55 or 87 obvious under 35 U.S.C. § 103(a) because the resulting device still would not include each element of the claims. The proposed combination does not include a “seal” as required by claims 55 and 87. The device of McGarrigle is described as shielding light curable compositions from undesirable ambient light, but does not describe a “seal” of any kind. To the contrary, McGarrigle discusses the importance

of maintaining the device in a level position because the bonding agents contained in the depressions 20 and 22 are “capable of being spilled.” The device clearly does not include a seal as required by claims 55 and 87 if the contents of the device can be spilled even when the container is “closed.” The tamper-evident label of Petrick et al. does nothing to remedy this deficiency in the device of McGarrigle, and does not provide a “seal” within the meaning of claims 55 or 87. Even if the tamper-evident label of Petrick et al. were incorporated into the device of McGarrigle, the contents of the resulting device will still be “capable of being spilled” and the device will still fail to include a “seal” as required by claims 55 or 87. Accordingly, the proposed combination fails to include each element of the claims 55 and 87 and thus cannot render these claims obvious under 35 U.S.C. § 103(a).

Ultimately, the proposed combination is contrary to the teachings of McGarrigle, destroys the functionality of the tamper-evident label as taught by Petrick et al., and does not include each element of claims 55 or 87. The proposed combination cannot render claims 55 or 87 obvious under 35 U.S.C. § 103(a), and it is respectfully requested that the rejection be reversed. Because claims 56 through 58, 61 through 64, 84, 86, 89, and 90 all properly depend from either claim 55 or 87, they too are patentable over McGarrigle in view of Petrick et al., and it is requested that the rejections of these claims be reversed also.

Second Ground of Rejection

Claims 60, 88, 91, and 92 were rejected under 35 U.S.C. § 103(a) as unpatentable over McGarrigle in view of Petrick et al. and further in view of U.S. Patent No. 4,991,759 (Scharf). The Examiner indicated that the combination of McGarrigle and Petrick et al. includes each feature of the claimed invention, but fails to include that the base, lid, and hinge are integrally molded, that the breakable seal can be broken by pushing the lid in a direction substantially towards the container, or that an appendage is created at the breakable seal during activation and provides a friction fit between the lid and second end of the container when the lid is pushed onto the container. The Examiner concluded, however, that it would have been obvious to include all of these features into the combination of McGarrigle and Petrick et al. as taught by Scharf. Appellants disagree that the proposed combinations render claims 60, 88, 91, or 92 obvious under 35 U.S.C. § 103(a) for at least the following reasons and respectfully request that the rejections be reversed.

Scharf describes a dispenser for maintaining light sensitive substances shielded from light. Abstract. A sealing lip 38 is provided on the lower surface of cover 14 which inserts into the upper portion of container 16 thereby causing cover 14 to sealably mate with the container. Col. 3, ll. 66–68, Col. 4, ll. 1–3; Figs. 2–3.

As discussed in response to the First Ground of Rejection above, and incorporated herein by reference, the combination of McGarrigle and Petrick et al. is contrary to the teachings of McGarrigle and destroys the functionality of the tamper-evident label as taught by Petrick et al. Therefore, one of skill in the art would not logically make the proposed combination. Even if the combination were made, the resulting device would not include each element of claims 55 or 87 at least because the proposed combination lacks a “seal.” Accordingly, independent claims 55 and 87 are not obvious under 35 U.S.C. § 103(a) in view of McGarrigle in further view of Petrick et al. Scharf does nothing to remedy these deficiencies, and the claims are therefore also patentable over the three-way combination of references. Claims 60, 88, 91 and 92 properly depend from claims 55 or 87 and are similarly in condition for allowance. It is respectfully requested that the rejections of claims 60, 88, 91, and 92 be reversed.

Regarding claims 88 and 91, Appellants further disagree with the rejection at least because Scharf does not disclose or suggest a breakable seal that can be broken by pushing the lid in a direction substantially towards the container. The Examiner indicates that when surface 38 reaches the top of the container, it creates a seal, and that the seal is broken when the lid is pressed further on the container. Scharf makes no mention of pushing the lid further onto the container, however, and it is not clear how this could even occur without damaging the device. Accordingly, the proposed combination fails to disclose or suggest the claimed seal, and it therefore does not include each element of claims 88 and 91 and cannot render these claims obvious under 35 U.S.C. § 103(a). It is respectfully requested that the rejections be reversed.

Regarding claims 92, Appellants further disagree with the rejection at least because Scharf does not describe an appendage created at the breakable seal during activation that provides a friction fit between the lid and second end of the container when the lid is pushed onto the container. The Examiner cites Col. 3, l. 66 – col. 4, l. 7 as support for the rejection. Scharf describes no such feature, however, in the cited passage or elsewhere. Because Scharf does not disclose a breakable seal or an appendage that is *created* at the breakable seal *during activation*, the

proposed combination cannot render claim 92 obvious under 35 U.S.C. § 103(a). It is accordingly requested that the rejection be reversed for this additional reason.

Third Ground of Rejection

Claim 73 was rejected under 35 U.S.C. § 103(a) as unpatentable over McGarrigle in view of Petrick et al. and further in view of U.S. Patent No. 5,660,273 (Discko, Jr.). The Examiner indicated that the combination of McGarrigle with a tamper-evident label as taught by Petrick et al. includes each feature of claim 73, but does not disclose a package including a disposable applicator. The Examiner concluded that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a disposable applicator as taught by Discko, Jr. Appellants disagree that the proposed combination renders claim 73 obvious under 35 U.S.C. § 103(a) for at least the following reasons and respectfully request that the rejections be reversed.

As discussed in response to the First Ground of Rejection above, and incorporated herein by reference, the combination of McGarrigle and Petrick et al. is contrary to the teachings of McGarrigle and destroys the functionality of the tamper-evident label as taught by Petrick et al. Therefore, one of skill in the art would not logically make the proposed combination. Even if the combination were made, the resulting device would not include each element of independent claim 55 at least because the proposed combination lacks a “seal.” Accordingly, independent claim 55 is not obvious under 35 U.S.C. § 103(a) in view of McGarrigle in further view of Petrick et al. Discko, Jr. does nothing to remedy these deficiencies. Claim 73 properly depends from claim 55 and is similarly in condition for allowance. It is respectfully requested that the rejection of claim 73 be reversed.

CONCLUSION

For the foregoing reasons, Appellants respectfully request that the Board reverse the Examiner on all counts.

Respectfully submitted,

December 8, 2010

Date

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CLAIMS APPENDIX

1-54 (Canceled).

55. (Previously Presented) A package assembly for placement on a surface and for storing and/or delivering substances such as dental substances, comprising:

- a) at least one container comprising a base and a lid; and
- b) at least one hinge connecting the base and the lid;

wherein the base and the lid comprise first and second levers, and the container can be opened by moving the first and second levers towards each other;

and wherein the container contains at least one dental substance and is sealed with a breakable tamper-evident seal.

56. (Previously Presented) The package assembly according to claim 55, wherein the hinge is provided between the first and second lever.

57. (Previously Presented) The package assembly according to claim 55, wherein the container is adapted for air-tight closing of the container with the seal.

58. (Previously Presented) The package assembly according to claim 55, wherein an end of the second lever is bent in a direction away from the first lever.

59. (Canceled)

60. (Previously Presented) The package assembly according to claim 55, wherein the base, the lid and the hinge are integrally molded.

61. (Previously Presented) The package assembly according to claim 55, wherein the base and/or the lid are manufactured with an opening for filling the container after manufacturing and for sealing with a seal.

62. (Previously Presented) The package assembly according to claim 61, wherein the container is sealed with a seal at a first end.

63. (Previously Presented) The package assembly according to claim 62, wherein the seal is a foil, a plug, or part of the base.

64. (Previously Presented) The package assembly according to claim 62, wherein the seal is a foil, a plug, or part of the lid.

65. Canceled.

66. (Withdrawn – Currently Amended) The package assembly according to claim ~~[[65]]55~~, wherein a back surface of the base comprises a non-skid and/or sticky layer for standing the package assembly on a surface.

67. (Withdrawn – Currently Amended) The package assembly according to claim ~~[[65]]55~~, wherein the assembly further includes a ring member, to enable a user to wear the package assembly like a ring on at least one finger.

68. (Withdrawn - Currently Amended) The package assembly according to claim ~~[[65]]55~~, wherein at least a back surface of the base comprises a soft elastic material.

69. (Withdrawn– Previously Presented) The package assembly according to claim 55, wherein the first or second levers comprise a fixation mechanism for attaching the second lever to the first lever and to ensure that the lid stays open after having been opened.

70. (Withdrawn– Previously Presented) The package assembly according to claim 69, wherein the fixation mechanism comprises a recess and a clip device for releasably engaging the clip with the recess.

71. (Withdrawn– Previously Presented) The package assembly according to claim 69, wherein the fixation mechanism comprises a fork at one lever and a snapper at the second lever for releasably engaging said snapper with the fork.
72. (Withdrawn) The package assembly according to claim 69, wherein the fixation mechanism comprises sticky glue or pressure sensitive adhesive for attaching the first and second levers together.
73. (Previously Presented) The package assembly according to claim 55, wherein the package comprises a disposable applicator.
74. (Withdrawn– Previously Presented) The package assembly according claim 55, wherein the assembly comprises at least two containers.
75. (Withdrawn) The package assembly according to claim 74, wherein the at least two containers are provided separately with independent openings.
76. (Withdrawn) The package assembly according to claim 74, wherein the at least two containers comprise one common lid.
77. (Withdrawn– Previously Presented) The package assembly according to claim 76, wherein the common lid is T-shaped, and the two containers are arranged side by side.
78. (Withdrawn) The package assembly according to claim 55, further comprising an area adapted for swabbing a brush or a mixing cavity for mixing components with a brush.
79. (Withdrawn) The package assembly according to claim 78, wherein the mixing cavity is part of the container and is re-closable by the lid.
80. (Withdrawn) The package assembly according to claim 55, wherein the lid comprises a second container adapted for storing a substance.

81. (Withdrawn– Previously Presented) The package assembly according to claim 80, wherein the second container and/or the lid comprises a bore adapted for connecting the container with the second container of the lid for dispensing the substance into the container.

82. (Withdrawn) The package assembly according to claim 80, wherein the bore is sealed by a base foil of a sachet.

83. (Withdrawn) The package assembly according to claim 81, wherein upon activation the base foil of the sachet will rupture at the bore for dispensing the additional substance into the container.

84. (Previously Presented) The package assembly according to claim 55, wherein the package assembly exhibits an orange color, to filter blue light.

85. (Withdrawn) The package assembly according to claim 55, wherein the container is sealed with a foil.

86. (Previously Presented) The package assembly according to claim 55, wherein the lid or container comprise a self-cleaning or low energy surface.

87. (Previously presented) A method for providing dental substances, comprising the steps of:

a) providing a package assembly comprising at least one container comprising a base and a lid and at least one hinge connecting the base and the lid, wherein the base and the lid comprise first and second levers, and wherein the container can be opened by moving the first and second levers towards each other, and wherein the container contains at least one dental substance and is sealed with a breakable tamper-evident seal, and

b) opening the package assembly by pressing the two levers together.

88. (Previously Presented) A method for providing dental substances according to claim 87, comprising before step b) the further step:

a1) pressing the lid in substantially the direction of the container for breaking the seal.

89. (Previously Presented) A method for providing dental substances according to claim 87, comprising after step b) the further step:

c) closing the container by pressing the lid onto the container.

90. (Previously Presented) The assembly according to claim 55, wherein the substance comprises at least one of the materials selected from the group consisting of: dental primers; bondings; etching gel/liquids; filling materials, such as composites, resin modified glass ionomer cements; temporary filling material; varnishes; glue, such as cyanoacrylate; pharmaceuticals, such as liquids, gels, pastes; varnishes; nail polish; touch up paints; cosmetics, such as lip gloss; a substance for the treatment or prevention or identification of caries; a substance for the prevention or identification or removal of plaque; a substance for root canal treatment; a substance for the removal of carious or decayed or infected dentine or enamel and/or a substance for the removal of denaturated dentine.

91. (Previously Presented) The package assembly according to claim 55, wherein the breakable seal can be broken by pushing the lid in a direction substantially towards the container.

92. (Previously Presented) The package assembly according to claim 55, wherein an appendage is created at the breakable seal during activation and provides a friction fit between the lid and second end of the container when the lid is pushed onto the container.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.